

PATENT**Application # 10/717,823****Attorney Docket # 2003P00225US01 (1009-049)****REMARKS**

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 2, 4, 5, 9-11, 13, 15, 17, 18, 42, and 43 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claim 7 has been cancelled without prejudice or disclaimer.

Claim 17 was amended solely for purposes of addressing an informality, and thus, not for reasons related to patentability.

Claims 1-6 and 8-43 are now pending in this application. Each of claims 1, 42, and 43 are in independent form.

The Obviousness Rejections

Each of claims 1-43 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of U.S. Patent No. 7,047,442 ("Sutton"), "Final Report: Safety-Related Complex Electronic Systems" ("STSARCES"), U.S. Patent No. 6,901,346 ("Tracy"), U.S. Patent No. 6,397,111 ("Niwa"), U.S. Publication No. 2004/0064253 ("Brayton"), and/or U.S. Patent No. 5,247,664 ("Thompson"). Each of these rejections is respectfully traversed.

PATENT**Application # 10/717,823****Attorney Docket # 2003P00225US01 (1009-049)****I. Legal Standards****A. *Prima Facie* Criteria for an Obviousness Rejection**

Over 50 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*'s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *Id.* at 1355, 1357.

Instead, "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach... all the claim limitations." *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See, In re Ochiai*, 71 F.3d

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1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

“Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, ‘the burden of coming forward with evidence or argument shifts to the applicant.’” *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

B. Unfounded Assertions of Knowledge

A bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). That is, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

C. Motivation or Suggestion to Combine References

Under the *Graham* analysis, the “examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” *See*, MPEP 2142. The requirements for meeting this burden are clear.

To factually support a *prima facie* conclusion of obviousness, an Office Action must clearly and objectively prove “the reasons one of ordinary skill in the art would have been motivated to select the references”. *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998); *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006).

Further, “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed” (emphasis added). *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *In re Sang-Su Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

To show these reasons, “[p]articular findings must be made”. *In re Kotzab*, 217 F.3d

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1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Such factual findings must be supported by "concrete evidence in the record". *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Moreover, a showing of combinability must be "clear and particular". *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 161 (Fed. Cir. 1999). That strong showing is needed because, "**obviousness requires proof** 'that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed'". *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006) (quotation omitted) (emphasis added).

Thus, the Office Action must clearly, particularly, and objectively prove some "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

"select the references";

"select the teachings of [the] separate references"; and

"combine [those teachings] in the way that would produce the claimed" subject matter.

In re Johnston, 435 F.3d 1381 (Fed. Cir. 2006) (internal citations omitted). *See also, In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (discussing "the test of whether it would have been obvious to select **specific** teachings and combine them as did the applicant") (emphasis added); and *Interconnect Planning Corp. v. Fell*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) ("When prior art references require selective combination... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself."). "The absence of . . . a suggestion to combine is dispositive in an obviousness determination." *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

Further, these requirements apply regardless of whether the Office Action relies upon modifying or combining purported teachings.

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious modification of the prior art. The mere fact that the prior art may be modified in

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the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the **desirability** of the modification.... It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); and *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (internal quotations omitted) (emphasis added)).

II. Analysis**A. Claim 1****1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

2. Missing Claim Limitations

Claim 1 states, *inter alia*, "providing a user interface adapted for selecting a sequential ordering of a plurality of computer-assisted verification tests to perform, the plurality of computer-assisted verification tests comprising the verification test". The present Office Action alleges, at Page 5, that Sutton teaches this claimed subject matter at "column 7, lines 29-35. This applied portion of Sutton allegedly states:

[t]he next level 202 corresponds to the procedure itself. A procedure is an ordered list, sequence, or script of tests to be run. Several procedures may exist, which is represented in FIG. 2 by a deck of cards 202, each representing a

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different procedure. Each procedure includes a plurality of tests, i.e., test 1, test 2, test 3 . . . test N, as shown at 203. Each test includes a plurality of measurements.

Applicant respectfully notes that this applied portion of Sutton makes no mention of a "user interface", or "selecting a sequential ordering of a plurality of computer-assisted verification tests". Thus, the applied portions of Sutton do not teach, "providing a user interface adapted for selecting a sequential ordering of a plurality of computer-assisted verification tests to perform, the plurality of computer-assisted verification tests comprising the verification test".

The applied portions of STSARCES fail to cure at least these deficiencies of the applied portions of Sutton.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

3. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

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Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**."

Instead, regarding selected proffered combinations, the present Office Action, at Page 4, states:

it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate validating of safety features as taught in STSARCES into the testing system of Sutton to create a testing system that encompasses validation of safety features ... it would it would have been obvious to one of ordinary skill in the art at the time of invention to induce error conditions as taught in STSARCES into the testing system of Sutton to create a testing system that establishes a close relationship with analytical models.

Applicant respectfully asks, where this assertion provides any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references"?
2. "select the teachings of [the] separate references"? and
3. "combine [those teachings] in the way that would produce the claimed" subject matter?

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

For at least this reason, Applicant respectfully requests a withdrawal of the rejection of claim 1. Also, a withdrawal of each rejection of claims 2-6 and 8-41, each ultimately depending from independent claim 1, is respectfully requested.

PATENT**Application # 10/717,823****Attorney Docket # 2003P00225US01 (1009-049)****B. Claim 2****1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 2 depends from claim 1.

2. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 2.

C. Claim 3**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 3 depends from claim 1.

2. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 3.

D. Claim 4**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 4 depends from claim 1.

PATENT**Application # 10/717,823****Attorney Docket # 2003P00225US01 (1009-049)****2. Missing Claim Limitations**

Claim 4 states, *inter alia*, "providing a user interface adapted for selecting the verification test from a plurality of potential computer-assisted verification tests". The present Office Action alleges, at Page 4, that Sutton teaches this claimed subject matter at "column 7, lines 29-33. Yet this applied portion of Sutton recites:

[t]he next level 202 corresponds to the procedure itself. A procedure is an ordered list, sequence, or script of tests to be run. Several procedures may exist, which is represented in FIG. 2 by a deck of cards 202, each representing a different procedure.

Applicant respectfully notes that this applied portion of Sutton makes no mention of a "user interface" or "selecting the verification test". Thus, the applied portions of Sutton do not teach, "providing a user interface adapted for selecting the verification test from a plurality of potential computer-assisted verification tests".

The applied portions of STSARCES fail to cure at least these deficiencies of the applied portions of Sutton.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

3. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

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1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 4.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 4.

4. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 4.

E. Claim 5**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 5 depends from claim 1.

PATENT**Application # 10/717,823****Attorney Docket # 2003P00225US01 (1009-049)****2. Missing Claim Limitations**

Claim 5 states, *inter alia*, “providing a user interface adapted for selecting the verification test from a plurality of potential computer-assisted verification tests, the plurality of potential computer-assisted verification tests limited by a stage of development of the machine system”. The present Office Action alleges, at Page 13, that Tracy teaches this claimed subject matter at “column 10, lines 37-45. Yet, this applied portion of Tracy recites:

[i]n step 1102 (FIG. 11), and based at least in part on the information entered in step 100, pertinent regulations will be selected from this repository, upon which to build a security requirement traceability matrix (SRTM) for the C&A. The SRTM, as discussed above, can be a mapping of one or more test procedures to each individual requirement within a requirements document. Satisfactory completion of the respective one or more test procedures that can be mapped to each requirement is generally considered to render the requirement satisfied.

Applicant respectfully notes that this applied portion of Sutton makes no mention of a “user interface”, “a user interface adapted for selecting the verification test”, or limiting “the plurality of potential computer-assisted verification tests” by “a stage of development of the machine system”. Thus, the applied portions of Sutton do not teach, “providing a user interface adapted for selecting the verification test from a plurality of potential computer-assisted verification tests, the plurality of potential computer-assisted verification tests limited by a stage of development of the machine system”.

The applied portions of the applied portions of the relied upon references fail to cure at least these deficiencies of the applied portions of Sutton.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of

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obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 5.

F. Claim 6**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 6 depends from claim 1.

2. Missing Claim Limitations

Claim 6 states, *inter alia*, "receiving a user selection of the verification test from a plurality of potential computer-assisted verification tests". The present Office Action alleges, at Page 4, that Sutton teaches this claimed subject matter at "column 7, lines 33-40. Yet this applied portion of Sutton recites:

[e]ach procedure includes a plurality of tests, i.e., test 1, test 2, test 3 . . . test N, as shown at 203. Each test includes a plurality of measurements. This is illustrated in FIG. 2 for test 2 shown at 205. As shown, test 205 includes measurements 207, i.e., measurement 1, measurement 2, . . . , measurement N. Each measurement includes one or more datapoints, represented as a deck of cards 210, 211, 212, associated with each measurement.

Applicant respectfully notes that this applied portion of Sutton makes no mention of a "user interface" or "a user selection of the verification test". Thus, the applied portions of Sutton do not teach, "receiving a user selection of the verification test from a plurality of potential computer-assisted verification tests".

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The applied portions of STSARCES fail to cure at least these deficiencies of the applied portions of Sutton.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

3. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 6.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or

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3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 6.

4. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 6.

G. Claim 8**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 8 depends from claim 1.

2. Missing Claim Limitations

Claim 8 states, *inter alia*, "receiving a user selection of a sequential ordering of a plurality of computer-assisted verification tests to perform, the plurality of computer-assisted verification tests comprising the verification test". The present Office Action alleges, at Page 5, that Sutton teaches this claimed subject matter at "column 7, lines 29-35. Yet, this applied portion of Sutton allegedly states:

[t]he next level 202 corresponds to the procedure itself. A procedure is an ordered list, sequence, or script of tests to be run. Several procedures may exist, which is represented in FIG. 2 by a deck of cards 202, each representing a different procedure. Each procedure includes a plurality of tests, i.e., test 1, test 2, test 3 . . . test N, as shown at 203. Each test includes a plurality of measurements.

Applicant respectfully notes that this applied portion of Sutton makes no mention of a "user selection" or "a user selection of a sequential ordering of a plurality of computer-assisted

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verification tests". Thus, the applied portions of Sutton do not teach, "receiving a user selection of a sequential ordering of a plurality of computer-assisted verification tests to perform, the plurality of computer-assisted verification tests comprising the verification test".

The applied portions of STSARCES fail to cure at least these deficiencies of the applied portions of Sutton.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

3. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 8.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

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1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 8.

4. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 8.

H. Claim 9**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 9 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 9.

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Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 9.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 9.

I. Claim 10**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 10 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

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Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** “in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**” regarding the additional subject matter of claim 10.

Applicant respectfully submits that the Office Action fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 10.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 10.

J. Claim 11**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 11 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;

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2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 11.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 11.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 11.

K. Claim 12**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 12 depends from claim 1.

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The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 12.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 12.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 12.

L. Claim 13**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant

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respectfully incorporates by reference each traversal regarding claim 1 since claim 13 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 13.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 13.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 13.

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None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 14 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 14.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 14.

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For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 14.

N. Claim 15**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 15 depends from claim 1.

2. Missing Claim Limitations

Claim 15 states, *inter alia*, "removing the induced error condition". The present Office Action alleges, at Page 7, that Sutton teaches this claimed subject matter at "column 8, lines 22. This applied portion of Sutton states, "[f]rom left to right, recorder buttons 301 are about 302, restart test 303, restart measurement 304, pause 305, run 306, skip measurement 307, skip test 308."

Applicant respectfully notes that this applied portion of Sutton makes no mention of an "error condition". Thus, the applied portions of Sutton do not teach, "removing the induced error condition".

The applied portions of STSARCES fail to cure at least these deficiencies of the applied portions of Sutton.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of

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obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

3. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 15.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 15.

O. Claim 16**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant

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respectfully incorporates by reference each traversal regarding claim 1 since claim 16 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 16.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 16.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 16.

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None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 17 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination" regarding the additional subject matter of claim 17.

Instead, the present Office Action asserts, at Page 14:

it would have been obvious to one of ordinary skill in the art at the time of invention to place the machine tool in a test mode as taught in Niwa into the testing system of Sutton to create a testing system.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

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Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 17.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 17.

Q. Claim 18**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 18 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 18.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";

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2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 18.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 18.

R. Claim 19**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 19 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 19.

Instead, the present Office Action asserts, at Page 14:

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it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate human verification as taught in Brayton into the testing system of Sutton and STSARCES to create a more flexible testing system.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 19.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 19.

S. Claim 20**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 20 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents no proof, and notably no evidence whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";

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2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 20.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 20.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 20.

T. Claim 21**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 21 depends from claim 1.

PATENT**Application # 10/717,823****Attorney Docket # 2003P00225US01 (1009-049)****2. No Motivation or Suggestion to Combine the Applied References**

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 21.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 21.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 21.

U. Claim 22**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant

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respectfully incorporates by reference each traversal regarding claim 1 since claim 22 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 22.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 22.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 22.

PATENT**Application # 10/717,823****Attorney Docket # 2003P00225US01 (1009-049)****V. Claim 23****1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 23 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 23.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 23.

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For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 23.

W. Claim 24**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 24 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** “in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of **making the combination**” regarding the additional subject matter of claim 24.

Applicant respectfully submits that the Office Action fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

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Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 24.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 24.

X. Claim 25**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 25 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 25.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";

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2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 25.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 25.

Y. Claim 26**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 26 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 26.

Instead, the present Office Action asserts, at Page 14:

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it would have been obvious to one of ordinary skill in the art at the time of invention to updating the status after a correction is implemented as taught by Thompson into the testing system of Sutton and STSARCES to a testing system which allows for the continued processing.

To the extent that Applicant understands this largely unintelligible assertion, Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 26.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 26.

Z. Claim 27**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 27 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

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1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 27.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 27.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 27.

AA. Claim 28**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 28 depends from claim 1.

PATENT**Application # 10/717,823****Attorney Docket # 2003P00225US01 (1009-049)****2. No Motivation or Suggestion to Combine the Applied References**

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 28.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 28.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 28.

BB. Claim 29**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant

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respectfully incorporates by reference each traversal regarding claim 1 since claim 29 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** “in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**” regarding the additional subject matter of claim 29.

Applicant respectfully submits that the Office Action fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 29.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 29.

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None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 30 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 30.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 30.

PATENT**Application # 10/717,823****Attorney Docket # 2003P00225US01 (1009-049)****3. Conclusion**

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 30.

DD. Claim 31**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 31 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination" regarding the additional subject matter of claim 31.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

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Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 31.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 31.

EE. Claim 32**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 32 depends from claim 1.

2. Missing Claim Limitations

Claim 32 states, *inter alia*, "generating a report of the verification test, the report comprising initial conditions". The present Office Action alleges, at Page 10, that Sutton teaches this claimed subject matter at "column 7, lines 55-67 and lines 28-35. At column 7, lines 55-67, Sutton states:

[a] measurement, such as measurement 206, is a configuration or a set up for a test. Each measurement, in measurements 207, within a test 205 can have different setups or configuration parameters. Tests are parameter driven and the parameters are inputs at the measurement level. Measurements are elements such as range in volts, frequency in kilohertz or harmonic (an integer number). The test procedure 202 views the measurements 207 as data to be passed from the procedure to a test. A measurement is also a phase of test execution. During the measurement phase of test execution, the measurement is started but data is not collected. This allows for multiple devices under test (DUTs) to be configured and triggered together.

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At column 7, lines 28-35, Sutton states:

[t]he next level 202 corresponds to the procedure itself. A procedure is an ordered list, sequence, or script of tests to be run. Several procedures may exist, which is represented in FIG. 2 by a deck of cards 202, each representing a different procedure. Each procedure includes a plurality of tests, i.e., test 1, test 2, test 3 . . . test N, as shown at 203. Each test includes a plurality of measurements.

Applicant respectfully notes that this applied portion of Sutton makes no mention of a "report" or "the report comprising initial conditions". Thus, the applied portions of Sutton do not teach, "generating a report of the verification test, the report comprising initial conditions".

The applied portions of STSARCES fail to cure at least these deficiencies of the applied portions of Sutton.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

3. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

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Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** “in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**” regarding the additional subject matter of claim 32.

Applicant respectfully submits that the Office Action fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 32.

4. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 32.

FF.Claim 33**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 33 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;

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2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 33.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 33.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 33.

GG. Claim 34**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 34 depends from claim 1.

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The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 34.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 34.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 34.

HH. Claim 35**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant

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respectfully incorporates by reference each traversal regarding claim 1 since claim 35 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 35.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 35.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 35.

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None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 36 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 36.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 36.

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For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 36.

JJ. Claim 37**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 37 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** “in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**” regarding the additional subject matter of claim 37.

Applicant respectfully submits that the Office Action fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

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Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 37.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 37.

KK. Claim 38**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 38 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 38.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";

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2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 38.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 38.

LL. Claim 39**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 39 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 39.

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Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 39.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 39.

MM. Claim 40**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 40 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

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Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** “in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**” regarding the additional subject matter of claim 40.

Applicant respectfully submits that the Office Action fails to provide any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 40.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 40.

NN. Claim 41**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. Applicant respectfully incorporates by reference each traversal regarding claim 1 since claim 41 depends from claim 1.

2. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever**, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;

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2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**" regarding the additional subject matter of claim 41.

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Thus, the present Office Action fails to establish a *prima facie* case of obviousness regarding claim 41.

3. Conclusion

For at least these reasons, Applicant respectfully requests a withdrawal of the rejection of claim 41.

OO. Claim 42**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

2. Missing Claim Limitations

Claim 42 states, *inter alia*, "said compliance processor adapted to provide a user interface, said user interface adapted for selecting a sequential ordering of a plurality of computer-assisted verification tests to perform, the plurality of computer-assisted verification

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tests comprising the verification test". The present Office Action alleges, at Page 5, that Sutton teaches this claimed subject matter at "column 7, lines 29-35. This applied portion of Sutton allegedly states:

[t]he next level 202 corresponds to the procedure itself. A procedure is an ordered list, sequence, or script of tests to be run. Several procedures may exist, which is represented in FIG. 2 by a deck of cards 202, each representing a different procedure. Each procedure includes a plurality of tests, i.e., test 1, test 2, test 3 . . . test N, as shown at 203. Each test includes a plurality of measurements.

Applicant respectfully notes that this applied portion of Sutton makes no mention of a "user interface", or "selecting a sequential ordering of a plurality of computer-assisted verification tests". Thus, the applied portions of Sutton do not teach, "said compliance processor adapted to provide a user interface, said user interface adapted for selecting a sequential ordering of a plurality of computer-assisted verification tests to perform, the plurality of computer-assisted verification tests comprising the verification test".

The applied portions of STSARCES fail to cure at least these deficiencies of the applied portions of Sutton.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

PATENT**Application # 10/717,823****Attorney Docket # 2003P00225US01 (1009-049)****3. No Motivation or Suggestion to Combine the Applied References**

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**."

Instead, regarding selected proffered combinations, the present Office Action, at Page 4, states:

it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate validating of safety features as taught in STSARCES into the testing system of Sutton to create a testing system that encompasses validation of safety features ... it would it would have been obvious to one of ordinary skill in the art at the time of invention to induce error conditions as taught in STSARCES into the testing system of Sutton to create a testing system that establishes a close relationship with analytical models.

Applicant respectfully asks, where this assertion provides any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references"?
2. "select the teachings of [the] separate references" and
3. "combine [those teachings] in the way that would produce the claimed" subject matter?

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

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1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

For at least this reason, Applicant respectfully requests a withdrawal of the rejection of claim 42.

PP.Claim 43**1. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

2. Missing Claim Limitations

Claim 42 states, *inter alia*, "providing a user interface adapted for selecting a sequential ordering of a plurality of computer-assisted verification tests to perform, the plurality of computer-assisted verification tests comprising the verification test". The present Office Action alleges, at Page 5, that Sutton teaches this claimed subject matter at "column 7, lines 29-35. This applied portion of Sutton allegedly states:

[t]he next level 202 corresponds to the procedure itself. A procedure is an ordered list, sequence, or script of tests to be run. Several procedures may exist, which is represented in FIG. 2 by a deck of cards 202, each representing a different procedure. Each procedure includes a plurality of tests, i.e., test 1, test 2, test 3 . . . test N, as shown at 203. Each test includes a plurality of measurements.

Applicant respectfully notes that this applied portion of Sutton makes no mention of a "user interface", or "selecting a sequential ordering of a plurality of computer-assisted verification tests". Thus, the applied portions of Sutton do not teach, "providing a user interface adapted for selecting a sequential ordering of a plurality of computer-assisted verification tests to perform, the plurality of computer-assisted verification tests comprising the verification test".

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The applied portions of STSARCES fail to cure at least these deficiencies of the applied portions of Sutton.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, still do not expressly or inherently teach every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

3. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything** "in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the **combination**."

Instead, regarding selected proffered combinations, the present Office Action, at Page 4, states:

it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate validating of safety features as taught in STSARCES into the testing system of Sutton to create a testing system that encompasses validation of safety features ... it would it would have been obvious to one of ordinary skill

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in the art at the time of invention to induce error conditions as taught in STSARCES into the testing system of Sutton to create a testing system that establishes a close relationship with analytical models.

Applicant respectfully asks, where this assertion provides any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references"?
2. "select the teachings of [the] separate references"? and
3. "combine [those teachings] in the way that would produce the claimed" subject matter?

Applicant respectfully submits that the Office Action fails to provide any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

For at least this reason, Applicant respectfully requests a withdrawal of the rejection of claim 43.

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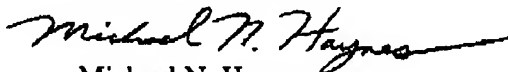
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Michael N. Haynes
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Date: 22 September 2006

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